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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,520	09/23/1999	MICHAEL O'CONNOR	42390.P6898	9567

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MICHAEL J MALLIE
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
7TH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES, CA 90025

EXAMINER

NALVEN, ANDREW L

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 07/08/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/405,520

Applicant(s)

O'CONNOR ET AL.

Examiner

Andrew L Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8,10-12,14-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,10-12,14-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Claims 1-3, 5-6, 8, 10-12, 14-17, and 19-20 are pending.
2. Amendment submitted 4/12/04 has been received and entered.

Response to Arguments

3. Applicant's arguments filed 12 April 2004 have been fully considered but they are not persuasive.

4. Applicant has argued on pages 6 and 7 that the Mukohzaka reference (US Patent No. 5,910,999) fails to teach the integration of several fingerprint samples over time to create a reference image. However, Applicant presented a synopsis of the teachings provided by Mukohzaka but has not provided an explanation of the alleged differences between the teachings of the Mukohzaka reference and the claims. Examiner maintains that Mukohzaka does in fact remedy the deficiencies of the Matchett reference (US Patent No. 5,229,764) with regards to the teaching of the integration of several fingerprint samples over time to create a reference image. Mukohzaka teaches the collecting of four fingerprint samples as a user places his/her finger in four different manners (Mukohzaka, column 4 lines 51-54). Examiner contends that the collection of four different samples in four different manners is evidence of a collection of samples over time (Mukohzaka, column 12 lines 43-45). Mukohzaka further teaches that the four samples that were collected over time are then integrated by first performing a Fourier transform on the samples (Mukohzaka, column 4 lines 62-

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66) and then integrating the samples into a single filter termed "Multi" (Mukohzaka, column 6 lines 40-63). The single integrated filter Multi is then employed as a reference fingerprint for use in comparison with other fingerprints (Mukohzaka, column 8 lines 14-25). Thus, Mukohzaka provides teachings for the integration of samples collected over time. Further, Applicant stated on Page 7 that Mukohzaka fails to teach the replacing of the first identity reference with a second identity reference. Examiner notes that Mukohzaka was not relied upon to teach the replacing of identity references, but instead was relied upon to teach the integration of samples over time. Examiner has relied upon the Okubo reference to teach the replacing of identity references.

5. In response to applicant's argument that there is no suggestion or motivation to combine the teachings of Mukohzaka and Okubo because the teachings of Okubo and Mukohzaka are incompatible, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Examiner contends that Matchett, Mukohzaka, and Obuko teach all of the elements of independent claims 1, 10 and 15 and Mukohzaka and Obuko provide motivation for their combination with Matchett (see paper #8).

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6. The following rejection is substantially similar to that found in paper number 8.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 6, 10-12, and 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matchett US Patent No. 5,229,764 in view of Mukohaka US Patent No. 5,910,999 and Okubo US Patent No 4,461,028.

9. In regards to claims 1, 10, and 15, Matchett discloses an authentication process that provides "biometric checks of a user" (column 3, lines 18-19). Matchett shows data collecting in "the recording of a particular user's relevant biometric characteristics" (column 4, lines 58-59) and data matching through "the comparison of new biometric data to the user's reference biometric data" (column 4, lines 65-66). Matchett discloses a database to store a first identity reference for the user (Figures 1 and 4). Matchett's disclosure outlined above does not include a data compiler to integrate samples of data collected over time to create a second identity reference or the replacing of the first identity reference with the second identity reference. Mukohzaka discloses a fingerprinting system that integrates samples of data collected over time (Mukohzaka, column 6 lines 40-63, column 8 lines 14-25, column 12 lines 41-48). The integration of several images into a combined filter provides a more accurate reference filter than that

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of a single image. Okubo discloses an identifying device in which a first identity reference is replaced with a second identity reference (Okubo, column 6 lines 6-16, column 4 lines 40-48, column 4 lines 61-64). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Mukohzaka's integration method in order to reduce false rejection and false acceptance ratios (Mukohzaka, column 1 lines 45-56). Further, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Okubo's method of updating identity references because it offers the advantage of ensuring that the identity of an object can be established correctly at all times even when the characteristics of the object change (Okubo, column 2 lines 12-32).

10. In regards to claims 2, 11, and 16, Matchett as modified teaches that the authentication process is made more secure by using "a plurality of biometric authentication devices" (column 4, lines 48-49). Further, Matchett discloses the storage of digital biometric data in a digital storage device in Figure 3.

11. In respect to claims 3, 12, and 17, Matchett as modified discloses a data analyzer coupled to a database that receives second reference data and first reference data to be analyzed and presents a comparison result (Matchett, column 6, lines 5-9).

12. In respect to claim 6, Matchett as modified discloses that a particular embodiment of the instant invention "may be used to...protect access to a network" (Matchett, column 8, lines 9-11).

13. Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matchett US Patent No. 5,229,764, Mukohaka US Patent No. 5,910,999, and Okubo US Patent No 4,461,028, as applied to claims 3 and 15 above, and in further view of Bianco et al US Patent No. 6,256,737. Matchett, Mukohzaka, and Okubo as outlined above fail to teach a network-based database of biometric user identities. Bianco discloses a biometric authentication system geared towards enterprise networks that places user biometric data on a "biometric server" that stores the "collection of data required by the system to authenticate users" (column 2, lines 57-58). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Bianco's network-based system as it would allow a group to deploy an authorization system across a wide geographic area.

14. Claims 5, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matchett US Patent No. 5,229,764, Mukohaka US Patent No. 5,910,999, and Okubo US Patent No 4,461,028, as applied to claims 3 and 17 above, and in further view of Dalude US Patent No. 6,310,966. Matchett, Mukohzaka, and Okubo fail to teach a system of embedding an identity reference into input data. Dalude shows a system wherein a first identity reference in the form of a digital certificate is attached to user data (column 3 lines 46-47). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Dalude's biometric digital certificates in order to allow verification of the source of user data transmitted across a network.

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Conclusion

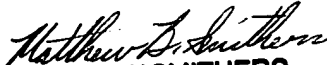
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L Nalven whose telephone number is 703 305 8407. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703 308 4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven




MATTHEW SMITHERS
PRIMARY EXAMINER
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